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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,939	06/23/2003	David Roy Pawloski	BCI-169US	7510
23122	7590	01/25/2005	EXAMINER	
RATNERPRESTIA P O BOX 980 VALLEY FORGE, PA 19482-0980			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,939

Applicant(s)

PAWLOSKI, DAVID ROY

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-32 and 34-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 5, 7-13, 30, 32 and 34-40 is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 14-18, 21, 23-24, 26-29, 31, 41-42 is/are rejected.
- 7) ☒ Claim(s) 19, 20, 22 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment submitted on 30 November 2004. Claims 6 and 33 have been canceled. Currently claims 1-5, 7-32 and 34-42 are pending. Upon further consideration the allowability of certain claims has been reconsidered in view of a new rejections which appear below.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 4, 27, 31 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassens, Jr (US Patent No. 3,879,208) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference because the MgO component of the reference is now excluded due to the use of the language of "consisting essentially of". To this argument the examiner respectfully disagrees. "Accordingly to MPEP 2111.03 [R-2] the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52,190 USPQ 461, 463 (CCPA 1976) (emphasis in original)...

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of" for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also > AK Steel Corp. v. Sollac, 344 F.3d 1234, 1240-41, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003) (Applicant's statement in the specification that "silicon contents in the coating metal should not exceed about 0.5% by weight" along with a discussion of the deleterious effects of silicon provided basis to conclude that silicon in excess of 0.5% by weight would materially alter the basic and novel properties of the invention. Thus, "consisting essentially of" as recited in the preamble was interpreted to permit no more than 0.5% by weight of silicon in the aluminum coating.);< In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd.Pat. App. & Inter. 1989)." There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not

seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

4. Claims 1, 4, 27, 31, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. JP02-197836 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is

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nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 05-127323 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the

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reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

6. Claims 1, 4, 27, 31 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 06-194791 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to

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the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Chinese Patent Specification No. 1153593 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition



and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

8. Claims 1, 2, 4, 27, 29, 31 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by over Diesso (US Patent No. 6,695,901) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

***Claim Rejections - 35 USC § 103***

9. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 04-170368 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not rendered obvious by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Also it should be noted that the limitation of "for treating a surface of a ferrous metal" is an intended utility and as such it adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it renders obvious the instant claims.

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10. Claims 1, 4, 14-18, 21, 23-24, 26-28, 31 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Patent No. 4,401,526) for the reasons set forth in the previous office action and which are herein incorporated by reference.

As stated in the last office action the reference teaches, in the examples and the claims, an aqueous zinc alloy plating bath comprising various additives. According to column 3, lines 14+, various additional additives or agents may be added which include aluminum sulfate, citric acid, boric acid, alcohols, etc. meeting the limitations of claims 1, 4, 14, 23, 24, 27, 31 and 41 and that the pH can be adjusted to from 0 to about 8.9 depending on the bath utilized which encompasses the pH range claimed in claims 16, 28 and 42.

The instant claims are obvious over the reference. While the reference does not specifically teach the instant composition it does suggest the formation of a composition that encompasses that which is instantly claimed. Note that according to the examples the composition is for treating steel which according to applicant's specification is considered to be a ferrous metal thus meeting the independent claims as well as claim 26. The limitation of instant claim 24 is suggested in column 3, lines 20+, which teaches the addition of various alcohols. The reference teaches that the temperature of the bath is normally between 60°F and 160°F which encompasses the range instantly claimed in claims 15 and 21. As for the type of steel utilized (instant claim 21), while the reference does specifically recite the use of a high carbon steel it would have been obvious to one of ordinary skill in the art to utilize any type of steel absent evidence showing otherwise without producing any unexpected results as the reference broadly

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recites the use of "steel" and therefore it is believed that all types of steel would be useable absent evidence showing otherwise. While applicant argues that the instant claims are not rendered obvious by the reference because the other components recited in the reference as now excluded by the use of "consisting essentially of" terminology. To this argument the examiner respectfully disagrees. As stated in Item #3 above: There is nothing on the record to show that the addition of the other component(s) would materially affect a composition for treating a surface of metal and therefore the consisting essentially of language is not seen to exclude its presence or inclusion in the claimed composition. Note that the instant claims contain no amounts or properties or anything that would exclude the other material. There is nothing on the record to indicate that the composition of the reference could not be used to treat the surface of a ferrous metal and accordingly the instant claims are met by the reference. Furthermore the composition of the reference is used to treat ferrous metal surfaces such as steel. As for the treatment period (claims 17-18), this appears to be a matter of obvious choice or design as one would find it obvious to adjust the treatment period according to what is needed or desired. That is, it is believed that a longer treatment would result in the formation of a thicker coating and therefore one would find it obvious to adjust the treatment period as necessary. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it renders obvious the instant claims.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2, 4, 23, 29, 31 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is inconsistent with claim 1 and accordingly it is confusing. Note that in claim 1 recites that the "polycarboxylic acid and precursor is selected from the group consisting of" and in claim 2 applicant recites that it "comprises at least one of". This is confusing as according to claim 1 the polycarboxylic acid is only selected from the group of acids recited (i.e. closed terminology) however claim 2 since it recites "comprises" appears to open the group up to the addition of those not present in claim 1. The same thing holds true for claim 4.

Claim 23 is inconsistent with claim 14 for the same reasons as claims 2 and 4 above. That is, claim 23 recites that the polycarboxylic acid "comprises" which is open terminology whereas claim 14 recites a specific group that is closed to those recited.

Claim 29 is inconsistent with claim 27 for the same reasons as claims 2 and 4 above. That is, claim 29 recites that the polycarboxylic acid "comprises" which is open terminology whereas claim 27 recites a specific group that is closed to those recited. The same holds true for claim 31.

Claim 42 is inconsistent with claim 41 as claim 41 recites "consisting essentially of" whereas claim 42 recites "further comprising". Applicant needs to use consistent terminology.

***Allowable Subject Matter***

13. Claims 3, 5, 7-13, 30, 32, 34-40 are allowable over the art of record as the prior art fails to teach and/or fairly suggest these claimed compositions.

14. Claims 19-20, 22, and 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
January 24, 2005